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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/775,536

02/10/2004

James J. Rudnick

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10/25/2006

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EXAMINER

ISABELLA, DAVID J

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,536

Applicant(s)

RUDNICK ET AL.

Examiner

DAVID J. ISABELLA

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/31/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of the Claims

Original claims as filed on 2/10/2004 included claims 1-18. However, applicant's statement filed concurrently with the original claims indicates that the present amendment include all of the originally filed claims which have been cancelled and new claims 54-60 are presented herewith. Claims 1-53 were not the originally filed claims of parent application SN 09/977823. Accordingly, applicant records and comments should be corrected to be consistent with the subject matter of the parent application.

Applicant responded:

Initially, it is noted that the Examiner indicates that the original claims filed on February 10, 2004 included claims 1-18. During subsequent prosecution, claims numbering 19-53 have been added. For clarity, Applicant filed the current claims in the present application as claims 54-60. While Applicant acknowledges that the original application was filed with 18 claims, the claim numbering used herein is believed to avoid any confusion with any previous related applications.

For clarity of the record, claims 19-53 have not been officially added by an amendment during the prosecution of this application. In order to be consistent with the numbering of the claims in the instant application, claims 54-60 have been renumbered as 19-25, respectively.

Response to Arguments

Applicant's arguments filed 7/31/2006 have been fully considered but they are not persuasive.

In the previous office action, the examiner argued that applicant failed to provide support in the original specification for claims 54-60 (now claims 19-25). Applicant's

argues that based on the limited disclosure on page 12, there is sufficient information to support the subject matter of claims 54-60 (now claims 16-25). Applicant provides no evidence to support such assertion other than the statement that "the stent must inherently be able to move, in part, with respect to the covering".

Applicant's specification at page 12 clearly states that the stent is supported to the membrane covering with little support necessary at the flexible central section of the stent. Thus, since there is "little support" at the central section of the stent, the stent must inherently be able to move, in part, with respect to the covering. Thus, it is submitted that no new matter has been entered into the disclosure by way of the independent claims presented herein and furthermore, that the independent claims are supported by the disclosure of the original application.

As such, examiner maintains that the subject matter of claims 54-60 (now claims 19-25) do not receive the benefits of the earlier filing date and therefor the rejection under Lau et al is maintained.

Specification

The amendment filed 2/10/2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Limitations as set forth in each of independent claim 54, 55 and 60 are not supported in applicant's specification as originally filed.

Independend claim 54:

“a tubular graft component substantially coaxial with said support component, said tubular graft component being attached to said support component only in-part, allowing unattached apexes to move longitudinally relative to said graft component; and said support component being slidably secured to said graft component such that relative movement therebetween is limited.”

Independent claim 55:

“a tubular graft component positioned substantially coaxially within said support component, said tubular graft component being attached to said support component to allow said apexes to move longitudinally relative to said graft component.”

Independent claim 60:

“a graft positioned substantially coaxially within said stent, said graft being attached to said stent to allow said apexes to move longitudinally relative to said graft.”

Independent claim 54 requires that the tubular graft be attached to the support component ***“only in-part”*** allowing the unattached apexes to move longitudinally relative to the graft component and that the support component is slidably secured to the graft component to allow relative but limited movement therebetween.

Applicant's specification, page 12, contains the only reference to the combination of a graft component and the support members.

“In certain situations the stent of the present invention may include a membrane covering (not shown) which would cover the entire stent. The wire surface of the stent would serve as a support surface for the membrane covering. The membrane covering would act as a further barrier to tissue ingrowth. Any membrane covering may be employed with the present invention such as a fabric or elastic film. Further, this membrane covering may be completely solid or may be porous. In addition, as above described, employing a formed wire having varied amplitude where the amplitude of the wire is smaller at the ends of the stent would help support the membrane covering as the crush-resistant ends would serve as anchors to support the membrane covering with little support necessary at the more flexible central section of the stent.”

Nowhere in applicant's original disclosure is there any reference as to how the graft is attached to the stent. Moreover, there is no mention that the graft be attached “in-part” thereby allowing the unattached apexes to move longitudinally relative to the graft component and that the stent is slidably secured to the graft.

With respect to claims 55 and 60, applicant's disclosure does not support the limitation of

a tubular graft component being attached to said support component/stent to allow the apexes to move longitudinally relative to said graft component.

Rejection to the Claims

The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Since applicant's original disclosure does not clearly support the limitations of the copied claims, applicant does not receive the benefits of the earlier filing date of the parent application SN 08/289791, the claims will be rejected under Lau, et al [6517570].

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-25 (originally claims 54-60) are rejected under 35 U.S.C. 102(b) as being anticipated by Lau,et al [6517570].

The claims were copied from the Lau, et al patent and therefor are anticipated by the same. Lau et al was issued on 2/11/2003 and has established priority back to 8/31/1994.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. ISABELLA whose telephone number is 571-272-4749. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA
Primary Examiner
Art Unit 3738

DJI
11/19/2006